

Notice of Allowability

Application No.

10/780,256

Examiner

Katherine W. Mitchell

Applicant(s)

O'BANION ET AL.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 1/27/06
2. ☒ The allowed claim(s) is/are 85-93,96-98 and 107-115.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some* c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|---|--|
| 1. <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input checked="" type="checkbox"/> Interview Summary (PTO-413), Paper No./Mail Date <u>20060330</u> . |
| 3. <input type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date _____ | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit of Biological Material | 8. <input type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input type="checkbox"/> Other _____. |

EXAMINER'S AMENDMENT

1. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.
2. Authorization for this examiner's amendment was given in a telephone interview with Jeff Urian on March 30-31, 2006.
3. The application has been amended as follows:

In the Claims:

Claim 85 lines 12-13 have been amended to delete "interior surface" and replace it with -longitudinal axis--.

Claim 107 line 14 has been amended to delete "first surface" and replace it with --longitudinal axis--.

Claims 99 - 103 and 106 have been cancelled.

Claims 110 - 115 have been added per below:

--110. (new) A method of fastening two or more framing members, having a strength of at least about 33 ksi, together with a piercing nail having a tip, a head and a stem extending there between, the stem having a concave interior surface and a convex exterior surface separated by a pair of side edges, a portion of the exterior surface curving toward the interior surface as the portion of the exterior surface extends axially toward the tip, and the edges each having a set of teeth extending axially there along, the method comprising:

(a) positioning the tip of the nail adjacent two or more adjacent framing members;

(b) applying a driving force to the head of the piercing nail;

(c) driving a portion of the nail through said framing members with said driving force until the head is in contact with one of said framing members; and

(d) engaging said framing members with at least one tooth of the sets of teeth so that removal of the nail from said framing members is inhibited and said framing members are fastened together between the head and the at least one tooth.

111. (new) The method of claim 110, wherein (b) includes applying a driving force with a force transmitting device.

112. (new) The method of claim 111, wherein (b) includes supporting a surface of said framing members opposite the nail with a back plate.

113. (new) The method of claim 111, further comprising loading a plurality of nested piercing nails in said force transmitting device.

114. (new) The method of claim 110, wherein (c) includes resiliently deforming a portion of the edges generally toward one another with said framing members as the nail passes through said framing members.

115. (new) The method of claim 110, wherein each tooth in the sets of teeth are staggered relative to one another and (d) includes engaging said framing members with at least one of said staggered teeth. --

4. The following is an examiner's statement of reasons for allowance:

The closest prior art is Newport USP 4354782, but Newport does not penetrate framing members of a strength of at least 33 ksi. However, this distinction alone would not be patentable, as it would be well within the skill in the art to select materials of different strength for the fastener to allow it to be used with framing members and structures of different strengths. The claimed fastener has the convex exterior surface curving toward said longitudinal axis as the exterior surface extends axially toward said first end, which Newport clearly lacks, as

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particularly shown in 3,5, and 10. Note that the exterior surface curving is NOT the same as the edges (between the concave interior and convex exterior) curving as shown at "20" in Newport -

- the claimed invention has the convex surface itself curving, thus reducing a radial distance from the longitudinal axis to the convex exterior as the exterior surface extends radially toward said first end. Further note that this curving towards the longitudinal axis does NOT require that the first end (the end configured to pierce) be either on, or offset from, the longitudinal axis -- the claim would read on either situation; as the curve could, but does not have to, continue past the longitudinal axis as the exterior surface extends axially toward said first end.

Further, applicant is clear that the first end must be capable of piercing metal with a strength of about 33 ksi or more - thus a blunt tip capable of piercing foil or very thin metal sheets does not read on the claims. Gisondi has 2 stems and Lombard is clear that the fastener is made of a thin relatively yieldable metal and is inserted in a pre-existing hole, thus it teaches away from a piercing tip":

pierced, pierc-ing, pierc-es
verb, transitive

1. To cut or pass through with or as if with a sharp instrument; stab or penetrate.
2. To make a hole or opening in; perforate. ¹

as the specification and drawings are clear that piercing requires making a hole in the metal framing members, not merely penetrating thru an existing hole.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

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5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katherine W. Mitchell whose telephone number is 571-272-7069. The examiner can normally be reached on Mon - Thurs 10 AM - 8 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J. Swann can be reached on 571-272-7075. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

6. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Katherine W Mitchell
Primary Examiner
Art Unit 3677

Kwm
3/30/2006

